

Remarks

1. Introduction

In the office action dated February 27, 2004, the Examiner rejected all pending claims. The Examiner rejected claims 4 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Harvey *et al.*, U.S. Patent No. 6,487,583 (“Harvey”). Additionally, the Examiner rejected claims 5, 12, and 16 under 35 U.S.C. § 103(a) as being obvious over a combination of Harvey and Lim *et al.*, U.S. Patent No. 6,574,599 (“Lim”). As shown above, the Applicant has amended claims 4, 6, 7, 12 and 15. Now pending are claims 4-8, 12, and 15, of which claims 4, 12, and 15 are independent and the remainder are dependent. Applicants respectfully request reconsideration of the claims, as amended, for the following reasons.

2. Response to Claim Rejections

a. Claims 4 – 8

The Examiner rejected independent claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Harvey. The Applicant respectfully traverses this rejection because there is no suggestion or motivation in Harvey to modify Harvey in the manner suggested by the Examiner, and as required by M.P.E.P. § 2143. Additionally, the proposed modification would not have been logical to a person of ordinary skill in the art at the time of the invention. And, even if modified in the way suggested by the Examiner, Harvey would result in something different than the claimed invention.

As the Examiner stated, Harvey is “silent regarding creating a second personal address book.” (Office Action, February 27, 2004, p. 3, at lines 16-17.) The Examiner then cited Harvey, column 17, at lines 27-42, as suggestive of the creation of a “newly created list” from “a

communication address book and pals list.” (*Id.*, at lines 22-26.) However, the cited portion of Harvey merely provides that the “client application reads a communication address book and pals list and puts the names and addresses into a list.” (Harvey, col. 17, at lines 36-41.) Consequently, Harvey’s newly created list is merely the result of picking names and addresses from the communication address book and the pals list, and then storing them together in a new list. The newly created list may be, at best, analogous to the claimed “first Personal Address Book containing a plurality of entries, each of said entries having associated connection information and an associated user.” But, it still does not equate to receiving acceptances from the associated users of selected ones of said entries marked in said marking step and, in response to receiving each of said acceptances, creating a second Personal Address Book for the user who provided the acceptance, as claimed.

Harvey contains no suggestion or motivation to create a second Personal Address book “for the user who provided the acceptance,” as claimed. Indeed, Harvey’s newly created list is generated for the inviting user, while the present invention’s second Personal Address book is created for the invitee. Harvey’s newly created list and the present invention’s second Personal Address Book are generated by different means and in response to different users carrying out different tasks. The newly created list in Harvey is created to facilitate the invitation process; it compiles the addresses of the desired invitees into one list so that it is easier for the party issuing the invitation to access the invitees’ names and addresses. (Harvey, col. 17, at lines 36-42.) In contrast, the claimed second Personal Address Book is created in response to *an invitee* accepting an invitation. The creation of this second Personal Address Book can then facilitate the growth of a subscriber community. Essentially, once an invitee accepts an invitation, a Personal Address Book is created for the invitee, and the invitee may populate it with

information, which may later be used to issue invitations to more invitees for whom Personal Address Books will similarly be created, and so on.

There is no suggestion in the sections referenced by the Examiner or anywhere else in Harvey to create a second Personal Address Book for an invitee who accepted an invitation, in response to that invitee's acceptance. Indeed, the only reason to modify Harvey in this way is the Applicant's invention. However, it is impermissible to use the Applicant's claims as a blueprint for hindsight reconstruction. Consequently, Harvey does not provide or suggest all of the elements of claim 4, and the Applicant submits that a *prima facie* case of obviousness of claim 4 does not exist.

Furthermore, it would not have been obvious to a person of ordinary skill in the art at the time of the invention to use Harvey's newly created list as a "second Personal Address Book for the user who provided the acceptance" because such use would essentially publish a given user's personal address book to each other user who accepted the given user's invitation. Such a result is different than the claimed invention, and is illogical because a person generally would not want to publish his or her own Personal Address Book so widely. As the specification of the present application explains, a Personal Address Book ("PAB") owner typically is "the only user of the telecommunication network that can access and modify his or her PAB." (Specification, page 2, at lines 14-16.)

Therefore, for the reasons stated above, claim 4 is patentable over Harvey. Claims 5-8 depend from claim 4, therefore, the Applicant submits that claims 5-8 are also patentable over Harvey.

b. Claims 5, 12 and 15

The Examiner rejected claims 5, 12 and 15 under 35 U.S.C. § 103(a) as being obvious over a combination of Harvey and Lim. Applicant respectfully traverses this rejection because the combination of Harvey and Lim does not disclose or suggest the combination of elements in any of claims 5, 12 or 15. Under M.P.E.P. § 2143, in order to establish a *prima facie* case of obviousness of a claimed invention by applying a combination of references, the proposed combination must teach or suggest all of the elements of the claimed invention. The combination of Harvey and Lim fails to do so.

Claim 5 ultimately depends from claim 4. Because Harvey fails to disclose or suggest all of the limitations of claim 4, for the reasons discussed above, Harvey necessarily also fails to disclose or suggest all of the limitations of dependent claim 5.

Claim 12 is directed to a service node in a telecommunications network, comprising (i) access means for accessing a Personal Address Book, said Personal Address Book containing a plurality of callers, (ii) selection means, coupled to said access means, for selecting callers in said Personal Address Book as invited callers, (iii) contact means, coupled to said selection means, for contacting said invited callers and asking said invited callers to join a subscribing community, (iv) reception means for receiving an answer from each of said invited callers, and (v) creation means, coupled to said reception means, for creating a plurality of second Personal Address Books in response to receiving said answers from said invited callers, wherein one second Personal Address Book is created respectively for each invited caller who provided an answer.

As was discussed previously with reference to claim 4, Harvey fails to disclose creation means, coupled to said reception means, for creating a plurality of second Personal Address

Books in response to receiving said answers from said invited callers, wherein one second Personal Address Book is created respectively for each invited caller who provided an answer. Therefore, Harvey fails to disclose or suggest all of the limitations of claim 12.

Claim 15 is directed to a computer program at a service node, comprising (i) first code for accessing a Personal Address Book, said Personal Address Book containing a plurality of callers, (ii) second code for selecting callers in said Personal Address Book as invited callers, (iii) third code for contacting said invited callers and asking said invited callers to join a subscribing community, (iv) fourth code for receiving an answer from each of said invited callers, and (v) fifth code for creating a plurality of second Personal Address Books in response to receiving said answers from said invited callers, wherein one second Personal Address Book is created respectively for each invited caller who provided an answer.

As discussed before, Harvey fails to disclose code for creating a plurality of second Personal Address Books in response to receiving said answers from said invited callers, wherein one second Personal Address Book is created respectively for each invited caller who provided an answer. Consequently, Harvey also fails to disclose or suggest all of the limitations of claim 15.

Lim does not make up for Harvey's deficiencies with respect to claims 5, 12, and 15. Lim is merely directed to voice-recognition-based methods, none of which involve the creation of a Personal Address Book in response to receiving acceptances from associated users who have been invited to subscribe to a subscribing community. Applicant further submits that the art provides no suggestion or motivation to extend Lim in this way, and that the only basis for extending Lim in this way is Applicant's claims, i.e., Applicant's invention. Consequently, the combination of Harvey and Lim fails to teach or suggest all of the elements of any of claims 5,

12, and 15. Therefore, Applicant respectfully submits that a *prima facie* case of obviousness does not exist for claims 5, 12, and 15, and that claims 5, 12 and 15 are patentable over Harvey and Lim.

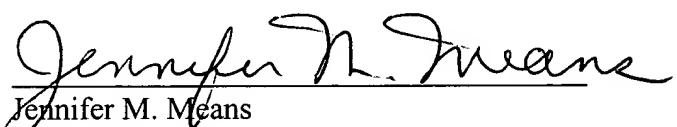
3. Conclusion

For the reasons set forth above, the Applicant submits that claims 4-8, 12, and 15 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance.

Respectfully submitted,

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